

530  
51  
11/11  
A5  
Cont'd

19. (once amended) A motor in accordance with Claim 18 wherein said plurality of fasteners are attached to said inner surface of said raised projections by at least one of a weld, a crimp, and an adhesive.

20. (once amended) A motor in accordance with Claim 14 wherein said plurality of fasteners are attached to said inner surface of said raised projection such that said fasteners are disposed inside inner surface.

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### Remarks

Applicants and the undersigned wish to express their appreciation to the Examiner for the courtesies she extended to Robert Reeser during a telephone interview that occurred on December 17, 2002. During the interview, the Office Action dated August 28, 2002 was discussed. More specifically, proposed claim amendments were discussed which were submitted by Applicants to overcome Fisher et al. (U.S. Patent No. 6, 005,314), Story et al. (U.S. Patent No. 3,787,014), and Boede et al. (U.S. Patent No. 4,933,809). No agreement was reached with respect to the patentability of the claims. The following amendment has been made in consequence thereof. Submitted herewith is a Submission of Marked Up Paragraphs and Claims.

Claims 1-20 are now pending in this application. Claims 1-20 stand rejected.

In accordance with 37 C.F.R. 1.136(a), a one month extension of time is submitted herewith to extend the due date of the response to the Office Action dated August 28, 2002, for the above-identified patent application from November 28, 2002, through and including December 28, 2002. In accordance with 37 C.F.R. 1.17(a)(3), authorization to charge a deposit account in the amount of \$110.00 to cover this extension of time request also is submitted herewith.

Applicants respectfully traverse the objection to the disclosure. The specification has been amended to address the informalities noted within the Office Action. Specifically, the specification was amended on page 3, line 3 to recite "a cavity 18 therein in which a motor" and on page 4, line 16 to recite "coupled to an applicable support". For the reasons set forth above, Applicants respectfully request that the objection to the disclosure be withdrawn.

The objection to the drawings under 37 CFR 1.83(a) is respectfully traversed. Applicants submit that under 37 C.F.R. 1.83(a), conventional features disclosed in the description and claims need not be shown in the drawings where the detailed illustration is not essential for a proper understanding of the invention. Applicants respectfully submit that

an illustration of the stator-rotor assembly recited in Claim 14 is not necessary for an artisan of ordinary skill in the art to understand the invention, and as such, is not essential for a proper understanding of the disclosed invention. For the reasons set forth above, Applicants respectfully request that the objection to the drawings be withdrawn.

The objection to the Claims is respectfully traversed. The Claims have been amended to address the informalities noted within the Office Action. Specifically, Claims 4, and 17-20 have been amended. For the reasons set forth above, Applicants respectfully request that the objection to the Claims be withdrawn.

The rejection of Claims 1-4 and 14-20 under 35 U.S.C. § 103(a) as being unpatentable over Fisher et al. (U.S. Patent No. 6, 005,314) ("Fisher") in view of Admitted Prior Art ("APA") of Figure 1 in view of Story et al. (U.S. Patent No. 3,787,014) ("Story") and in further view of Boede et al. (U.S. Patent No. 4,933,809) ("Boede") is respectfully traversed.

Fisher describes a motor (50) that includes a housing (54) formed by a motor shell (56) and a pair of endshields (58 and 60). A stator (72) is mounted within the motor shell. The motor also includes a base (92) for support and mounting. Notably, Fisher does not describe nor suggest a method for mounting a motor to a support that includes attaching fasteners to an inner surface of a housing using a plurality of attachment points within the housing such that the fasteners extend radially outwardly from the housing, and attaching the motor to a support using the plurality of fasteners. Additionally, Fisher does not describe nor suggest a housing that includes at least one raised projection extending outwardly from the housing wherein the projection includes an inner surface, at least one opening extending therethrough, and at least one fastener configured to attach to the inner surface and extend outwardly through the housing.

ADA describes a motor housing (10) that includes a shell (12) having an inner surface (14) and an outer surface (16). A plurality of mounting hardware or fasteners (20) are attached to the shell outer surface and extend radially outwardly from the shell outer surface. Fasteners (20) are spaced circumferentially around the housing and may be welded to shell outer surface (16).

Story describes a replacement motor mounting (50) that includes an adapter bracket (58) that includes a circular central portion and four arms. A set of fastener receiving holes (62, 64) is formed in the arms and is configured to receive a plurality of fasteners (66) extending axially from an endshield. Notably, Story does not describe nor suggest at least

one fastener configured to attach to an inner surface of a motor housing and extend outwardly through the motor housing.

Boede describes a modular assembly of diverse electrical components housed in a box (10). The box is closed with a cover (47) that includes a plurality of recessed mounting holes (56) configured to receive a plurality of mounting screws (52). Notably, Boede does not describe nor suggest at least one fastener configured to attach to an inner surface of a motor housing and extend outwardly through the motor housing. Rather, Boede describes fasteners that are configured to attach to an outer surface of a housing and extend inwardly through the housing.

Claim 1 recites “a method for mounting a motor to a support using a mounting system, the mounting system including a plurality of fasteners, the motor including a pair of endshields and a housing extending therebetween, the housing including a plurality of openings, said method comprising attaching the fasteners to an inner surface of the housing using a plurality of attachment points within the housing, such that the fasteners extend radially outwardly from the housing...and attaching the motor to the support using the plurality of fasteners.”

None of Fisher, APA, Story, or Boede, considered alone or in combination, describe or suggest a method for mounting a motor to a support using a mounting system that includes a plurality of fasteners, wherein the motor includes a pair of endshields and a housing that extends therebetween, and the housing includes a plurality of openings, wherein the method includes the steps of attaching the fasteners to an inner surface of the housing using a plurality of attachment points within the housing such that the fasteners extend radially outwardly from the housing, and attaching the motor to the support using the plurality of fasteners.

More specifically, none of Fisher, APA, Story, or Boede, alone or in combination, describe or suggest a method for mounting a motor to a support that includes attaching fasteners to an inner surface of a housing using a plurality of attachment points within the housing such that the fasteners extend radially outwardly from the housing, and attaching the motor to the support using the plurality of fasteners.

Rather, Fisher describes a motor that includes a housing formed by a motor shell and a pair of endshields. ADA describes a motor housing that includes a shell having an inner surface and an outer surface, and a plurality of fasteners attached to the shell outer surface

that extend radially outwardly from the shell outer surface. Story describes a replacement motor mounting that includes a set of fastener receiving holes that are configured to receive a plurality of fasteners that extend axially from an endshield. Boede describes a box that includes a cover having a plurality of recessed mounting holes that are configured to receive a plurality of mounting screws that are configured to attach to an outer surface of the housing and extend inwardly through the housing. For at least the reasons set forth above, Claim 1 is submitted to be patentable over Fisher in view of APA, Story and Boede.

Claims 2-4 depend directly from independent Claim 1. When the recitations of Claims 2-4 are considered in combination with the recitations of Claim 1, Applicants submit that dependent Claims 2-4 likewise are patentable over Fisher in view of APA, Story and Boede.

Claim 14 recites “a motor comprising a pair of endshields...a housing extending between said endshields including at least one raised projection extending outwardly from said housing, said projection comprising an inner surface, at least one opening extending therethrough, and at least one fastener configured to attach to said inner surface and extend outwardly through said housing....”

None of Fisher, APA, Story, or Boede, considered alone or in combination, describe or suggest a motor that includes a pair of endshields, a housing extending between the endshields that includes at least one raised projection extending outwardly from the housing, wherein the projection includes an inner surface, at least one opening extending therethrough, and at least one fastener that is configured to attach to the inner surface and extend outwardly through the housing. Specifically, none of Fisher, APA, Story, or Boede, considered alone or in combination, describe or suggest a housing that includes at least one raised projection extending outwardly from the housing wherein the projection includes an inner surface, at least one opening extending therethrough, and at least one fastener that is configured to attach to the inner surface and extend outwardly through the housing.

Rather, Fisher describes a motor that includes a housing formed by a motor shell and a pair of endshields. ADA describes a motor housing that includes a shell having an inner surface and an outer surface, and a plurality of fasteners attached to the shell outer surface that extend radially outwardly from the shell outer surface. Story describes a replacement motor mounting that includes a set of fastener receiving holes that are configured to receive a plurality of fasteners that extend axially from an endshield. Boede describes a box that includes a cover having a plurality of recessed mounting holes that are configured to receive

a plurality of mounting screws that are configured to attach to an outer surface of the housing and extend inwardly through the housing. For at least the reasons set forth above, Claim 14 is submitted to be patentable over Fisher in view of APA, Story and Boede.

Claims 15-20 depend, directly or indirectly, from independent Claim 14. When the recitations of Claims 15-20 are considered in combination with the recitations of Claim 14, Applicants submit that dependent Claims 15-20 likewise are patentable over Fisher in view of APA, Story and Boede.

Furthermore, Applicants respectfully submit that the Section 103 rejection of the presently pending claims is not a proper rejection. As is well established, obviousness cannot be established by combining the teachings of the cited art to produce the claimed invention, absent some teaching, suggestion, or incentive supporting the combination. None of Fisher, APA, Story, or Boede, considered alone or in combination, describe nor suggest the claimed combination. Furthermore, in contrast to the assertion within the Office Action, Applicants respectfully submit that it would not be obvious to one skilled in the art to combine Fisher with APA, Story and Boede, because there is no motivation to combine the references suggested in the art. Additionally, the Examiner has not pointed to any prior art that teaches or suggests to combine the disclosures, other than Applicants' own teaching. Rather, only the conclusory statement that "[i]t would have been obvious to one skilled in the art at the time the invention was made to modify the housing by providing a plurality of fasteners circumferentially spaced about the housing and extending outwardly therefrom because one would have been motivated to enable the motor to be attached within an application as taught by the APA Figure 1 (lines 3-6 of page 1 of the instant specification)" suggests combining the disclosures.

As the Federal Circuit has recognized, obviousness is not established merely by combining references having different individual elements of pending claims. Ex parte Levengood, 28 U.S.P.Q.2d 1300 (Bd. Pat. App. & Inter. 1993). MPEP 2143.01. Rather, there must be some suggestion, outside of Applicant's disclosure, in the prior art to combine such references, and a reasonable expectation of success must be both found in the prior art, and not based on Applicant's disclosure. In re Vaeck, 20 U.S.P.Q.2d 1436 (Fed. Cir. 1991). In the present case, neither a suggestion or motivation to combine the prior art disclosures, nor any reasonable expectation of success has been shown.

Furthermore, it is impermissible to use the claimed invention as an instruction manual or "template" to piece together the teachings of the cited art so that the claimed invention is

rendered obvious. Specifically, one cannot use hindsight reconstruction to pick and choose among isolated disclosures in the art to deprecate the claimed invention. Further, it is impermissible to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art. The present Section 103 rejection is based on a combination of teachings selected from multiple patents in an attempt to arrive at the claimed invention. Since there is no teaching nor suggestion in the cited art for the combination, the Section 103 rejection appears to be based on a hindsight reconstruction in which isolated disclosures have been picked and chosen in an attempt to deprecate the present invention. Of course, such a combination is impermissible, and for this reason alone, Applicants request that the Section 103 rejection be withdrawn.

For at least the reasons set forth above, Applicants respectfully request that the 35 U.S.C. § 103(a) of Claims 1-4 and 14-20 be withdrawn.

The rejection of Claims 5-13 under 35 U.S.C. § 103(a) as being unpatentable over Admitted Prior Art ("APA") of Figure 1 in view of Story and in further view of Boede is respectfully traversed.

ADA, Story, and Boede are described above.

Claim 5 recites "a housing for a motor extending between a pair of endshields, said housing comprising an inner surface...an outer surface...at least one raised projection extending outwardly from at least one of said housing inner surface and said housing outer surface, said projection comprising at least one opening extending therethrough...at least one fastener configured to attach to said inner surface and extend outwardly through said housing opening."

None of APA, Story, or Boede, considered alone or in combination, describe or suggest a housing for a motor that extends between a pair of endshields that includes an inner surface, an outer surface, at least one raised projection that extends outwardly from at least one of the housing inner surface and the housing outer surface wherein the projection includes at least one opening extending therethrough, and at least one fastener that is configured to attach to the inner surface and extend outwardly through the housing opening.

More specifically, none of APA, Story, or Boede, alone or in combination, describe or suggest at least one raised projection that extends outwardly from at least one of a housing inner surface and a housing outer surface wherein the projection includes at least one opening

extending therethrough, and at least one fastener that is configured to attach to the inner surface and extend outwardly through the housing opening.

Rather, ADA describes a motor housing that includes a shell having an inner surface and an outer surface, and a plurality of fasteners attached to the shell outer surface that extend radially outwardly from the shell outer surface. Story describes a replacement motor mounting that includes a set of fastener receiving holes that are configured to receive a plurality of fasteners that extend axially from an endshield. Boede describes a box that includes a cover having a plurality of recessed mounting holes that are configured to receive a plurality of mounting screws that are configured to attach to the outer surface of a housing and extend inwardly through the housing. For at least the reasons set forth above, Claim 5 is submitted to be patentable over APA in view of Story and Boede.

Claims 6-13 depend directly from independent Claim 5. When the recitations of Claims 6-13 are considered in combination with the recitations of Claim 5, Applicants submit that dependent Claims 6-13 likewise are patentable over APA in view of Story and Boede.

Furthermore, Applicants respectfully submit that the Section 103 rejection of the presently pending claims is not a proper rejection. As is well established, obviousness cannot be established by combining the teachings of the cited art to produce the claimed invention, absent some teaching, suggestion, or incentive supporting the combination. None of APA, Story, or Boede, considered alone or in combination, describe nor suggest the claimed combination. Furthermore, in contrast to the assertion within the Office Action, Applicants respectfully submit that it would not be obvious to one skilled in the art to combine APA with Story and Boede, because there is no motivation to combine the references suggested in the art. Additionally, the Examiner has not pointed to any prior art that teaches or suggests to combine the disclosures, other than Applicants' own teaching. Rather, only the conclusory statement that "[i]t would have been obvious to one skilled in the art at the time the invention was made to have modified the housing by providing a plurality of fasteners circumferentially spaced about the housing and extending outwardly therefrom because one would have been motivated to enable the motor to be attached within an application as taught by the APA Figure 1 (lines 3-6 of page 1 of the instant specification)" suggests combining the disclosures.

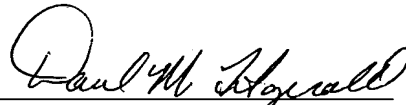
Furthermore, it is impermissible to use the claimed invention as an instruction manual or "template" to piece together the teachings of the cited art so that the claimed invention is rendered obvious. Specifically, one cannot use hindsight reconstruction to pick and choose

among isolated disclosures in the art to deprecate the claimed invention. Further, it is impermissible to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art. The present Section 103 rejection is based on a combination of teachings selected from multiple patents in an attempt to arrive at the claimed invention. Since there is no teaching nor suggestion in the cited art for the combination, the Section 103 rejection appears to be based on a hindsight reconstruction in which isolated disclosures have been picked and chosen in an attempt to deprecate the present invention. Of course, such a combination is impermissible, and for this reason alone, Applicants request that the Section 103 rejection be withdrawn.

For at least the reasons set forth above, Applicants respectfully request that the 35 U.S.C. § 103(a) of Claims 5-13 be withdrawn.

In view of the foregoing amendments and remarks, all the claims now active in this application are believed to be in condition for allowance. Reconsideration and favorable action is respectfully solicited.

Respectfully Submitted,



Daniel M. Fitzgerald  
Registration No. 38,880  
ARMSTRONG TEASDALE LLP  
One Metropolitan Square, Suite 2600  
St. Louis, Missouri 63102-2740  
(314) 621-5070



## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Thaylen K. Leany, et al.

Serial No.: 10/026,847 ✓

Filed: December 21, 2001

For: STUD MOUNTING SYSTEM

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Art Unit: 3632

Examiner: Naschica Morrison

## SUBMISSION OF MARKED UP PARAGRAPHS AND CLAIMS

Hon. Commissioner for Patents  
Washington, D.C. 20231

JAN 07 2003

Submitted herewith are marked up paragraphs and claims in accordance with 37 CFR  
Section 1.121(b)(1)(iii) and 1.211(c)(1)(ii).

IN THE SPECIFICATION

Please replace the paragraph beginning on page 3, line 1, with the following  
replacement paragraph:

Figure 1 is a side view of a known motor housing 10 including a shell 12 having an inner surface 14 and an outer surface 16. Shell 12 defines a cavity 18 therein in which a motor (not shown) is housed. A plurality of mounting hardware or fasteners 20 are attached to shell outer surface 16 and extend radially outwardly from shell outer surface 16. More specifically, fasteners 20 are spaced circumferentially around housing 10, and in the exemplary embodiment, are welded to shell outer surface 16.

Please replace the paragraph beginning on page 4, line 11, with the following  
replacement paragraph:

In the exemplary embodiment, projections 60 are identical, and each projection has an outer diameter 66. In an alternative embodiment, projections 60 are non-identical and are sized differently. An opening 68 extends substantially concentrically through each projection 60. Each opening 68 has a diameter 70 that is sized to receive a fastener 80 therethrough. Fastener 80 enables housing 30 to be coupled to an applicable support (not shown). In the exemplary embodiment, each fastener 80 is threaded and includes a head 82 including a top surface 84 and a bottom surface 86. Each respective projection 60 is sized to receive fastener

head 82 such that head top surface 84 is substantially co-planar with housing inner surface 52 when fastener 80 is fully installed within each projection 60.

IN THE CLAIMS

4. (once amended) A method in accordance with Claim 1 wherein the mounting system includes a plurality of fasteners, attaching the fasteners further [comprises] comprising crimping the fasteners to an inner surface of the housing.

5. (once amended) A housing for a motor extending between a pair of endshields, said housing comprising:

an inner surface;

an outer surface;

at least one raised projection extending outwardly from at least one of said housing inner surface and said housing outer surface, said projection comprising at least one opening extending therethrough; and

at least one fastener configured to attach to said inner surface and extend outwardly through said housing opening.

14. (once amended) A motor comprising:

a pair of endshields;

a housing extending between said endshields including at least one raised projection extending outwardly from said housing, said projection comprising an inner surface, at least one opening extending therethrough, and at least one fastener configured to attach to said [housing] inner surface and extend outwardly through said housing; and

a stator-rotor assembly mounted in said housing.

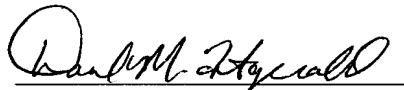
17. (once amended) A [housing] motor in accordance with Claim 14 wherein said inner surface of said raised projections comprises a plurality of attachment points configured to receive a fastener.

18. (once amended) A [housing] motor in accordance with Claim 14 wherein said housing comprises a plurality of fasteners configured to attach to said inner surface of said raised projections such that said fasteners extend outwardly from said housing.

19. (once amended) A [housing] motor in accordance with Claim [14] 18 wherein said plurality of fasteners are attached to [the housing] said inner surface of said raised projection by at least one of a weld, a crimp, and an adhesive.

20. (once amended) A [housing] motor in accordance with Claim 14 wherein said plurality of fasteners are attached to said inner surface of said raised projection such that said fasteners are disposed inside inner surface.

Respectfully Submitted,



Daniel M. Fitzgerald  
Registration No. 38,880  
ARMSTRONG TEASDALE LLP  
One Metropolitan Square, Suite 2600  
St. Louis, Missouri 63102-2740  
(314) 621-5070